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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Karl Nideborn

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EXAMINER

FREEMAN, JOHN D

ART UNIT

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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/551,814	Applicant(s) NIDEBORN ET AL.	
	Examiner John Freeman	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 19-30 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 19-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 6-8, 11, 14, 19, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Stopper et al. (WO 98/44025).

3. Regarding claims 1 and 4:

4. Stopper et al. (hereafter Stopper) disclose a film comprising a polymer and up to 1500 ppm of a mono-functional hindered phenol, such as α -tocopherol (abstract, p2 last paragraph).

5. While there is no disclosure that the film is for packaging purposes as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

6. It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the purpose or intended use, i.e. packaging purposes, recited in the present claims does not result in a structural difference between the presently claimed

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invention and the prior art and further that the prior art structure which is a polymer material identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

7. Regarding claims 6 and 11:

8. Given that the polymers useful for the invention include those claimed by Applicant, the examiner takes the position that said polymers provide a combination which gives a barrier and heat resistance. For example, Stopper teaches the use of EVOH (p8, ln 2-7).

9. Regarding claim 7:

10. Stopper provides for multilayer laminates (p7, ln 12-16).

11. Regarding claims 8 and 21:

12. The polymer may be ethylene or propylene (p8, ln 7-9).

13. Regarding claim 14:

14. The polyolefin polymers, polyethylene and polypropylene, are inherently heat-sealable.

15. Regarding claim 19:

16. Stopper teaches the use of other layers for "support," which the examiner interprets to include strengthening layers (p7, ln 12-16).

17. Claims 1-15 and 19-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Akao (US 5,234,750).

18. Akao discloses packaging made from polymers having vitamin E therein (abstract).

19. Regarding claims 1-3 and 28:

20. Akao uses up to 1% by weight of vitamin E (col 4 ln 45-48). Converting that to units used by Applicants, one arrives at over 10,100 ppm of vitamin E. (1% equates to 1g for every 99g of polymer, which further resolves to 10,101g for every 1,000,000g).

21. Regarding claim 4:

22. Akao includes α -tocopherol (col 4 ln 10-45).

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23. Regarding claims 5, 7, 9, 19-20, 22-23 and 29-30:

24. Akao clearly teaches that multilayer films from the given polymers. Given that the polymers include those found in the present claim 9, the layers made from said polymers would provide strengthening and heat resistant layers. For example, PVC is mentioned (col 7 ln 68).

25. Regarding claim 6:

26. Given that the polymers useful for the invention include those claimed by Applicant (see paragraphs 27-28 below), the examiner takes the position that said polymers provide a combination which gives a barrier and heat resistance.

27. Regarding claims 8 and 21:

28. The polymers include polyethylene, polypropylene, PVC, polycarbonate (col 7 ln 51+).

29. Regarding claims 10 and 24:

30. Given the polymers described by Akao are the same as those described by Applicant, the examiner takes the position that they would constitute "high temperature melting polymers" as presently claimed.

31. Regarding claim 11:

32. The film can include PVDC or PVOH layers (col 7 ln 65-col 8 ln 8).

33. Regarding claims 12, and 25-27:

34. The layers can be attached via adhesive (col 7 ln 51-56).

35. Regarding claim 13:

36. Example I discloses a packaging film 50 microns in thickness.

37. Regarding claim 14:

38. The polyolefin polymers, polyethylene and polypropylene, are inherently heat-sealable.

39. Regarding claim 15:

40. While there is no disclosure that the film is for packaging of liquid packaging objects as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the

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claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

41. It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. packaging of liquid packaging objects, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art and further that the prior art structure which is a polymer material identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

42. Claims 1, 4, 6, 8, 11, 14-15, 21, and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Seabrook et al. (US 5,554,373).

43. Regarding claims 1 and 28:

44. Seabrook et al. (hereafter Seabrook) disclose compositions containing anti-microbial agents and controllers, such as vitamin E, for use in polymeric materials (abstract). The vitamin E is added to the composition at a concentration of 50-2,000 ppm (col 5 ln 36-44). The composition can be made into a "container or film for protecting the contents thereof," i.e. packaging (col 6 ln 41-50).

45. Regarding claim 4:

46. The vitamin E is made from either a single tocopherol or a mixture of different tocopherols (col 8 ln 32-34). Given that there are only four tocopherols corresponding to vitamin E, the examiner takes the position that Seabrook's disclosure is detailed enough to anticipate α -tocopherol found in the present claim.

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47. Regarding claim 6:

48. Given that the polymers useful for the invention include those claimed by Applicant (see paragraphs 49-50 below), the examiner takes the position that the polymeric materials described by Seabrook provide a combination which gives a barrier and heat resistance.

49. Regarding claims 8 and 21:

50. The polymeric materials include polyethylene, polypropylene, and PVC (col 12 ln 20-30).

51. Regarding claim 11:

52. Although the present claim further limits the barrier layer of claim 6, neither claim requires its presence. Therefore, the reference meets all limitations of the claim.

53. Regarding claim 14:

54. The polyolefin polymers, polyethylene and polypropylene, are inherently heat-sealable.

55. Regarding claim 15:

56. The composition may be a bucket liner, which describes a container capable of containing liquids (col 6 ln 53).

Claim Rejections - 35 USC § 112

57. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

58. Claims 5-6, 8-10, 12, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

59. Claims 5 and 9 each contain the phrase "and/or and," which renders the claims indefinite. It appears Applicant intends for the claims to read simply "and."

60. Claim 6 contains the phrase "may comprise comprises a barrier layer," which renders the claim indefinite. It is unclear whether Applicant intends for the barrier layer to be optional. The examiner has interpreted the layer to be optional.

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61. Regarding claims 8 and 15, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

62. Regarding claim 10, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

63. Claim 12 recites "wherein any layer/s and/or barrier layer/s at least two of the layers," which renders the claim indefinite. The sentence structure leaves the claim very unclear. It appears Applicant intends for the claim to simply read "at least two of the layers."

Conclusion

64. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The examiner considers other primary documents cited on the related International Search Report to be relevant to the claims, but finds they would merely duplicate the rejections provided. Ichikawa (JP '736) discloses a polymer with up to 5% by weight tocopherols for use in cans. Muratoglu ('879) discloses a polymeric material containing vitamin E.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Freeman whose telephone number is (571)270-3469. The examiner can normally be reached on Monday-Friday 7:30-5:00PM EST (First Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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